

REMARKS

In this response, Applicant has not amended, canceled or added any claims. Thus, claims 2-10 and 15 remain pending.

Rejection of Claims 2, 6, 7 and 10 Under 35 U.S.C. §112

In the Final Office Action, the Examiner rejected claims 2, 6, 7 and 12 as indefinite under 35 U.S.C. § 112, para. 2. According to the Examiner, it is unclear which scenario Applicant is trying to claim, as claim 6 states that the adjusting piston extends into the adjusting chamber, while claims 2, 7 and 10 state that the adjusting piston extends into the master cylinder. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 2 and 7 recite a "master cylinder assembly" and "an adjusting piston adjustably extending into the master cylinder assembly." Claim 10 is similar, and recites "an adjuster piston threadingly engaged with the master cylinder assembly . . . ." However, in Claim 6, Applicant recites further aspects of its preferred embodiment of the master cylinder assembly by specifying that it comprises a main chamber and an adjuster chamber, and further specifying that the adjusting piston extends into the adjusting chamber. Thus, Claim 6 is not inconsistent with Claims 2, 7 and 10. It is merely more specific with respect to the master cylinder assembly structure and the location of the adjusting piston therein. One of ordinary skill

in the art could readily ascertain the scope of Claim 6 as well as Claims 2, 7, and 10. Thus, they are not indefinite.

Rejection of Claim 6 Under 35 U.S.C. § 102

The Examiner has rejected Claim 6 under 35 U.S.C. § 102(b) based on Gajek, et al., U.S. Patent No. 5,443,134 ("Gajek"). Claim 6 recites, inter alia, an adjusting piston threadingly engaged in an adjuster chamber of a master cylinder assembly. According to the Examiner, Gajek discloses a method of shifting gears in a hydraulic gear shift mechanism, wherein the mechanism comprises a main chamber having a master cylinder and an adjuster chamber (107) having an adjusting piston (108) threadingly engaged therein.

Applicant respectfully disagrees with the Examiner's characterization of Gajek. In Gajek, reference numeral 108, like reference numeral 8, refers to "a connecting element 8 for connecting the pressure line 9 with the fluid supply conduits 7, 13 . . . ." Gajek at 6:25-27.<sup>1</sup> Nowhere does Gajek suggest that the connectors could or should be operated as an adjusting piston. Moreover, Gajek's connecting elements must contain a

<sup>1</sup> Reference numeral 108 is shown in Figure 5 of Gajek, but is not specifically discussed in the specification. However, the specification states that "In the embodiment of FIG. 5, only the guide part 105 and the neck 114 differ from FIG. 1. The remaining structure of the receiving cylinder 101 essentially corresponds to the construction of the receiving cylinder 1, so that regarding its construction reference is made to the above description in connection with FIGS. 1 and 2." In FIGS. 1 and 2, reference numeral 8 refers to the connector identified as 108 in FIG. 5. Gajek indicates the correspondence between the first and second embodiments by adding 100 to the reference numerals of the first embodiment to obtain those used in the second embodiment. Gajek at 9:38-41.

through-bore to allow hydraulic fluid to flow from pressure chamber to the receiving cylinder 1. Thus, connectors 8 and 108 cannot be operated as an adjusting piston. To attempt to do so would twist and damage the pressure line 9. Thus, reconsideration and withdrawal of the rejection is respectfully requested.

Claim 15 was not addressed in the Examiner's Office Action. However, during the interview on June 7, 2004, she indicated that it would be treated identically to Claim 6. Like Claim 6, Claim 15 recites an adjusting piston threadingly engaged in an adjuster chamber of a master cylinder assembly. Thus, it is allowable over Gajek as well.

Rejection of Claims 2,3,5 and 10 Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 2, 3, 5 and 10 under 35 U.S.C. § 103(a) as obvious based on the combination of Kawakami, U.S. Patent No. 5,601,001 ("Kawakami I"), Gajek, and Kawakami, U.S. Patent No. 5,832,782 ("Kawakami II"). Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 2, 3, 5 and 10 all recite the inclusion of an adjusting piston in a master cylinder assembly. In applying the combined references, the Examiner again relies on Gajek in the manner noted above with respect to Claim 6. However, Gajek does not disclose an adjusting piston in a master cylinder assembly. Nor do Kawakami I or Kawakami II. Because, the combined

references do not teach or suggest all of the claim elements, Claims 2, 3, 5 and 10 are allowable over them.

Rejection of Claims 4 and 7 Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 4 and 7 as obvious under 35 U.S.C. § 103(a) based on the combination of Kawakami I and II, Gajek and Irwin, U.S. Patent No. 4,497,503 ("Irwin"). The Examiner has indicated that Kawakami I and II and Gajek are applied in the same manner as with respect to Claims 2, 3, 5 and 10. Irwin does not compensate for the deficiencies in the combination of Kawakami I and II and Gajek. Thus, Claim 4 (which depends from Claim 3) is allowable over the combined references for the same reason that Claim 3 is allowable over the combination of Kawakami I, Kawakami II and Gajek, as explained above. Because Claim 7 similarly recites an adjusting piston adjustably extending into a master cylinder assembly, it is also allowable over the combined references.

Rejection of Claims 8 and 9 Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 8 and 9 under 35 U.S.C. § 103(a) as obvious over the combination of Gajek and Kawakami I. However, the combination of Kawakami I and Gajek do not disclose or suggest the limitations of Claim 8. Thus, reconsideration and withdrawal of the rejection is respectfully requested.

Claim 8 recites a shift control lever that is operable in first and second directions, and which is biased in a neutral position between the first and second directions. It further recites operating the lever in the first direction to control the motion of the master piston in a push direction and operating the lever in the second direction to control the motion of the master piston in a return direction.

The combination of Kawakami I and Gajek do not teach or suggest the cooperation between a multi-directional control lever and a master piston, as recited in Claim 8. Kawakami I discloses a cable-based gear shifting apparatus which includes bi-directional gear shift lever. However, it makes no reference to the need for or benefit of using such a lever to control the motion of a master piston in a push direction or a return direction.

Gajek does not compensate for the deficiencies of Kawakami I. Gajek discloses a hydraulic brake system and discloses the use of the system for shifting bicycle gears. However, Gajek's brake lever 1b is not biased in the manner claimed. As shown in Figure 1, when lever 1b is in its neutral position, the transmitting cylinder piston 1c can only be moved in one direction, as can receiving cylinder piston 20. Thus, lever 1b is not operable in first and second directions and biased in a neutral position between them.

The combined references do not disclose or suggest the claimed operative relationship between a multi-directional

control lever and a master piston. The Examiner has suggested that the combined references would "provide a lever that can rotate forward and backward from a neutral position to provide more degrees of freedom in the lever, giving the rider more options." While that is an advantage of the claimed invention, it does not show that the prior art recognized the need to use a neutrally-biased, multi-directional lever to operate a master piston in the claimed manner. "When an obviousness determination is based on multiple prior art references, there must be a showing of some teaching, suggestion, or reason to combine the references." Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348 (Fed. Cir. 2000) (citations omitted). See also In re Stencel, 828 F.2d 751, 755 (Fed. Cir. 1987) ("Nor is obviousness established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made"). Because there is no motivation or suggestion in the prior art for combining Gajek and Kawakami I, the references cannot be properly combined to reject Claim 8 as obvious. Moreover, Gajek and Kawakami would have to be substantially modified to obtain the invention of Claim 8, further evidencing its non-obviousness. See, In Re Ratti, 270 F.2d 810, 813 (C.C.P.A. 1959) (reversing obviousness rejection where the suggested combination of references "would require a substantial reconstruction and redesign of the elements" in the prior art).

Claim 9 depends from Claim 8. Thus, it is similarly allowable for the foregoing reasons.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

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